

**REMARKS**

This is intended as a full and complete response to the Final Office Action dated October 29, 2003. Claims 1-11 and 24-29 stand initially rejected under 35 U.S.C. § 112 for informalities, and under 35 U.S.C. § 103 (a) over U.S. Pat. No. 5,996,316 (*Kirshcher*) in view of Official Notice and further in view of U.S. 5,685,435 (*Picioccio*). As to the informalities, it is believed that there is no lack of clarity in the claims, because the subsequent uses of the "products" refer with antecedent basis back to the "household cleaning and detergent products" recited in the preamble and in the first element of each independent claim. However, for the sake of furthering the application, claims 1, 4-11, 24-25, and 27-28, have been amended each without prejudice, to address this informality raised by the Examiner in the Final Office Action. The Examiner is respectfully requested to reconsider the rejections and to contact the undersigned if there are any remaining issues that the Examiner believes could be resolved in an interview that could result in allowance of the case.

Claims 1-2 and 4-11, 24-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,996,316 (*Kirschner*) in view of Official Notice and further in view of U.S. 5,685,435 (*Picioccio*). The Examiner states *Kirschner* discloses a system and method for a product substantially as claimed, but does not specifically show removing the bulk container from a pallet and transfer of product from the bulk container into an individual storage container for retail to the consumer, a beverage as a concentrated form that can be reconstituted later, or the use of a vending machine. The Examiner takes Official Notice that removing bulk containers from palletized loads, transferring a product from a bulk container to a individual storage container for consumer use, transferring a soft drink syrup in a concentrated form, and incorporation of a vending machine are well known and expected in the art. The Examiner also

states that the system of *Kirschner* could be extended to soft drinks, coffee, and other consumer products.

The Examiner admits that *Kirschner* does not disclose a household cleaning and detergent product. The Examiner relies on *Picioccio* to teach the concept and system for automated bulk vending of products at a retail location for giving consumers the option of selecting optional blends from a plurality of products. Without evidence, the Examiner states that it would have been obvious to include household cleaning and detergent consumer products in concentrated bulk form to be later reconstituted as a retail location.

The Applicant respectfully traverses the rejection. The Examiner has not produced any required evidence in the nature of cited references applicable to the particular field of the claimed subject matter and relies on Official Notice and extensions of the teachings to reject the claims. Now, even the Examiner does not extend Official Notice to household cleaning and detergent products. Thus, combining the two references with Official Notice does not rise to the level required by law to state a case of *prima facie* obviousness on the claimed subject matter of household cleaning and detergent products. The only example the Examiner supported with his earlier comments (believed to be part of the prior Official Notice) was the Laundromat example. Yet, that very example teaches away from the present invention and represents prior art in this field, where the individual containers of household cleaning and detergent consumer products are already prepackaged, predelivered, and presorted in the *final* retail form. Despite the long felt need, the solution was not seen by those with ordinary skill in the art prior to the present invention.

Further, the Examiner mistakenly places the burden on the Applicant. Whether relying on references or on Official Notice or both, the Examiner has not provided any evidence of the claimed subject matter specifically related to household cleaning and detergent products.

Stated differently, the cited references, among other things, relate to entirely different fields and the Official Notice does not supply the household cleaning and detergent products limitations in the claims. To the extent the Examiner's rejection seeks to supply the required motivation to combine through the nature of the problem, this aspect is also impermissible. *Teleflex Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1387 (CA FC 2002) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). "The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence." *Id.*

In *In re Dembiczak*, cited above, the Federal Circuit reversed both the Patent Office and the Board of Patent Appeals which attempted to combine children's art on decorated paper bags with plastic garbage bags to reject claims having art on plastic garbage bags. *Id.* at 1614. While children's art on decorated paper bags and garbage bags are each well known, there was no motivation to combine them, absent impermissible hindsight. The Court clearly held that the motivation was not present in the combination.

All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. To justify this combination, the Board simply stated that "the Holiday and Shapiro references would have suggested the application of . . . facial indicia to the prior art plastic trash bags." However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other—in combination with each other and the conventional trash bags—described

all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references . . . with the conventional trash or lawn bag references, nor does the Board make specific--or even inferential--findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

*Id.* at 1617-1618.

Three basic criteria must be met by the Examiner to establish a *prima facie* case of obviousness, according to the MPEP. There must: be a suggestion or motivation to modify the reference or combine references teachings, be a reasonable expectation of success, and teach or suggest all the claim limitations. (MPEP §§ 2142-2143.) Further, it "is difficult but necessary that the decision maker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art *who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.*" (MPEP § 2141.01, emphasis added, citing *W.L. Gore & Associates, Inc., v. Garlock, Inc.*, 7231 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Further, no reference is cited and no evidence is provided that supports the rejection of these and other features as merely matters of design choice, as required by case law. *In re Dembiczak*, 50 USPQ2d at 1617-1618; *see also, ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination."). The Examiner is respectfully requested to withdraw the rejection.

In conclusion, the references cited by the Examiner does not teach, show, or suggest the present invention. Therefore, it is believed that the rejections made by the Examiner have been obviated, and Applicant respectfully requests that the same be withdrawn. Allowance of the remaining claims is therefore respectfully requested.

Respectfully submitted,

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